

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSEL SHIRLEY, MICHAEL R. CONBOY,
and
HORACE PAUL BOWSER, JR.

Appeal No. 2004-0985
Application No. 10/010,412

ON BRIEF



Before THOMAS, OWENS, and BARRY, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

The effective filing date of the appellants' application is September 19, 2000. Hence, for US 2001/0047222 A1 to Wiesler et al. (Wiesler), which was filed on April 25, 2001, to be prior art, it must be effective as of its April 25, 2000 provisional application date.

The examiner states that "the Examiner ordered and reviewed the provisional application document and concluded that the

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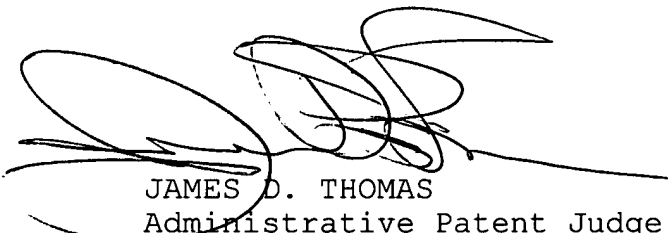
claims of the non-provisional application of '222 were adequately supported by the provisional disclosure" (answer, page 8). That statement is directed toward the issue of whether Wiesler's claims are entitled to Wiesler's provisional application filing date. The relevant issue in the present case is whether the subject matter in Wiesler's patent application publication that the examiner relies upon to reject the appellants' claims is disclosed in Wiesler's provisional application, which is a thirty-eight-page TransNet reticle management system functional specification. The examiner has not addressed that issue on the record. To establish that the relied-upon patent application publication disclosures appear in the provisional application, the examiner must point out the location in the provisional application of each relied-upon patent application publication disclosure.

We therefore remand the application for the examiner to point out on the record where each of Wiesler's patent application publication disclosures that the examiner relies upon in rejecting the appellants' claims appears in Wiesler's provisional application.

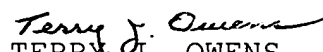
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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

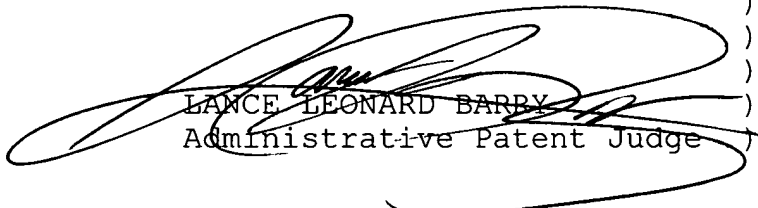
REMANDED



JAMES D. THOMAS
Administrative Patent Judge



TERRY J. OWENS
Administrative Patent Judge



LANCE LEONARD BARRY
Administrative Patent Judge

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